

1794

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|--|----------------------|------------------------|-------------------|
| PTO TRANSMITTAL FORM MAR 03 2008 (to be used for all correspondence after initial filing) | Application Number | 10/584,226 | |
| | Filing Date | June 23, 2006 | |
| | First Named Inventor | Walter Blum | |
| | Art Unit | 1794 | |
| | Examiner Name | Patricia L. Nordmeyer | |
| Total Number of Pages in This Submission | 8 | Attorney Docket Number | RO4265US (#90568) |

| ENCLOSURES (Check all that apply) | | |
|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): return postcard receipt |
| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|-------------------------------|----------|--------|
| Firm Name | D. Peter Hochberg Co., L.P.A. | | |
| Signature | | | |
| Printed name | D. Peter Hochberg | | |
| Date | February 29, 2008 | Reg. No. | 24,603 |

CERTIFICATE OF TRANSMISSION/MAILING

| | | | |
|---|--------------|------|------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | | | |
| Signature | | | |
| Typed or printed name | Sean Mellino | Date | 02/29/2008 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.

Pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2008☐ Applicant claims small entity status. See 37 CFR 1.27**Complete if Known**

| | |
|----------------------|-----------------------|
| Application Number | 10/584,226 |
| Filing Date | June 23, 2006 |
| First Named Inventor | Walter Blum |
| Examiner Name | Patricia L. Nordmeyer |
| Art Unit | 1794 |
| Attorney Docket No. | RO4265US (#90568) |

TOTAL AMOUNT OF PAYMENT (\$) 0.00

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 08-2441 Deposit Account Name: D. Peter Hochberg Co., L.P.A.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 310 | 155 | 510 | 255 | 210 | 105 | |
| Design | 210 | 105 | 100 | 50 | 130 | 65 | |
| Plant | 210 | 105 | 310 | 155 | 160 | 80 | |
| Reissue | 310 | 155 | 510 | 255 | 620 | 310 | |
| Provisional | 210 | 105 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|--|----------|-----------------------|
| Each claim over 20 (including Reissues) | 50 | 25 |
| Each independent claim over 3 (including Reissues) | 210 | 105 |
| Multiple dependent claims | 370 | 185 |

Total Claims - 20 or HP = _____ x _____ = _____ **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims - 3 or HP = _____ x _____ = _____ **Fee Paid (\$)**

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
|--------------|--------------|--|----------|---------------|
| _____ | _____ | _____ | _____ | _____ |

_____ - 100 = _____ / 50 = _____ (round up to a whole number) x 260.00 = 0.00

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

SUBMITTED BY

| | | | | | |
|-------------------|-------------------|-----------------------------------|-------------------|-----------|--------------|
| Signature | | Registration No. (Attorney/Agent) | 24,603 | Telephone | 216-771-3800 |
| Name (Print/Type) | D. Peter Hochberg | Date | February 29, 2008 | | |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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CERTIFICATE OF MAILING

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Date:

Feb. 29, 2008


Sean Mellino

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Walter Blum, et al.
Serial No. : 10/584,226 (Conf. No. 9147)
Filing Date : June 23, 2006
Examiner : Patricia L. Nordmeyer
Group Art Unit : 1794
Title : SEALING TAPE FOR ADHESIVE BONDING OF
VAPOUR BARRIER FILMS AND VAPOUR
RETARDER FILMS, AND PROCESS FOR ITS
MANUFACTURE
Attorney File : RO4265US (#90568)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Reply to Office Action Issued January 30, 2008

Dear Sir:

Claims 1-16 are pending in the instant application. The Examiner has concluded that restriction to one of the following groups is necessary:

- I. Claims 1-11 and 14-16, drawn to a self-adhesive, flexible sealing tape.
- II. Claims 12-13, drawn to a process for the manufacture of a self-adhesive, flexible sealing tape.

The Examiner explains in the Office action that the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features since claim 1 is either obvious over or anticipated by DE 100 63 018 A1. Accordingly, the Examiner states that the special technical feature linking the two inventions, self-adhesive core, does not provide a contribution over the prior art and so no single general inventive concept exists.

The Applicants hereby elect the claims of Group I (which reads on claims 1-11 and 14-16) for further prosecution on the merits thereof. However, the Applicants respectfully object to the instant restriction requirement, with traverse, as discussed below.

The present application pertains to a self-adhesive, flexible vapour barrier sealing tape comprising at least one flexible, self-adhesive core enveloped or coated from both sides by a second adhesive system. The core consists of a soft, permanently elastic hot melt adhesive and compensates and seals uneven surface areas, as well as ensures that the system continues to be adhesive and impervious even in case of damage to the surrounding envelope/coating. In addition to the elasticity/flexibility of the core, the core should mainly fulfill the requirements of being immediately adhesive, solvent-free (i.e., environmentally harmless) and aging-resistant. The envelope or coating comprises a second adhesive system, namely, an expanded pressure-sensitive adhesive tape which is manufactured on the basis of a pure dispersion acrylate, but could also be manufactured on the basis of a vinyl isobutyl ether or an isobutene. The envelope/coating has a foam-

like structure due to small, thermoplastic hollow plastic spheres filled with hydrocarbon gas and which expand upon exposure to a temperature in the range between 70°C and 140°C. The well-balanced cooperation of the two components of the tape is essential for its purpose as a lasting and a non-removable, or substantially non-removable, adhesive sealing tape, i.e., at least not removable without leaving any residue.

On the other hand, DE 100 63 018 describes a strippable double-sided adhesive foil comprising a base film of elastomers and 30 – 70 wt% adhesive resin, coated on both sides with a pressure sensitive acrylate adhesive. The main purpose of this foil is the adhesive bonding in conditions of high atmospheric humidity, especially for sticking onto vinyl wallpaper in such an atmosphere, and at the same time the possibility of removing the adhesive foil without damaging the substrate and without leaving any residue by pulling the laminate in the plane of the joint. Essential for these purposes are the nature and coating weights of the adhesive acrylates which are used, such as cross-linked hot melt acrylic adhesives or pressure sensitive adhesives which are based on an acrylate copolymer.

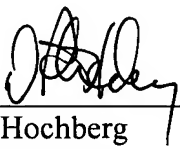
The Applicants therefore respectfully submit that the purposes and compositions of the adhesive tapes recited in the present claims and those in DE 100 63 018 are quite different and claim 1 of the present application is neither obvious nor anticipated by DE 100 63 018. Therefore, the technical features of claim 1 and 12 do link the two presumed inventions such that a single general inventive concept exists. It is submitted that the existence of the single general inventive concept should be acknowledged.

The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

Date: February 29, 2008

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By: 
D. Peter Hochberg
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